

REMARKS/ARGUMENTS

On page 3 of the Office Action, claims 314-318, 320, 321, 324-328, 330, 333, 335-338, 356, 410, and 443-446 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

On pages 3-6 of the Office Action, claims 314, 315, 321, 324, 330, 333, 335-337, 410, 443, 444, 448, 453, 454, 459-463 and 466 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 4,863,195 to Capozzola (the “Capozzola patent”) in view of U.S. Patent No. 5,462,488 to McKillip (the “McKillip patent”) and U.S. Patent No. 5,407,718 to Popat, et al. (the “Popat patent”).

On pages 6-7 of the Office Action, claims 316, 325, 356, 449, 455 and 465 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the Capozzola patent in view of the McKillip patent and the Popat patent, and further in view of U.S. Patent No. 5,656,705 to Mallya, et al. (the “Mallya patent”).

On pages 7-8 of the Office Action, claims 317, 318, 320 and 450-452 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the Capozzola patent in view of the McKillip patent and the Popat patent, and further in view of U.S. Patent No. 5,670,226 to Yoshizawa, et al. (the “Yoshizawa patent”).

On pages 8-9 of the Office Action, claims 326, 327, 456 and 457 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the Capozzola patent in view of the McKillip patent and the Popat patent, and further in view of U.S. Patent No. 4,704,317 to Hickenbotham, et al. (the “Hickenbotham patent”).

On pages 9-10 of the Office Action, claims 328 and 458 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the Capozzola patent in view of the McKillip patent and the Popat patent, and further in view of U.S. Patent No. 5,622,758 to Hollis, et al. (the “Hollis patent”).

On pages 10-11 of the Office Action, claims 338 and 464 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the Capozzola patent in view of the McKillip patent and the Popat patent, and further in view of U.S. Patent No. 5,842,722 to Carlson (the “Carlson patent”).

On page 11 of the Office Action, claim 445 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the Capozzola patent in view of the McKillip patent and the Popat patent, and further in view of U.S. Patent No. 5,495,981 to Warther (the “Warther patent”).

Applicants respectfully traverse the rejections of claims 314-318, 320, 321, 324-328, 330, 333, 335-338, 356, 410, and 443-466 for the reasons set forth below.

The Invention

Before addressing the specific claim limitations, it will be helpful first to briefly summarize the invention of the pending claims.

The present invention resides in a sheet of printable business cards including a paper cardstock sheet and a continuous liner sheet releasably secured to the paper cardstock sheet with ultraremovable adhesive. The sheet of printable business cards also includes continuous through-cut lines through the paper cardstock sheet but not through the continuous liner sheet. The continuous through-cut lines define, at least in part, perimeter edges of a printable business card in the paper cardstock sheet. The printable business card has a surface that is coupled to the ultraremovable adhesive. The printable business card is configured to be removed from the continuous liner sheet exposing the ultraremovable adhesive on the continuous liner sheet and the non-tacky printable business card's surface.

The present invention also resides in a sheet of printable business cards including a cardstock sheet and a continuous liner sheet releasably secured to the cardstock sheet with a layer of ultraremovable adhesive. The sheet of printable business cards also

includes continuous through-cut lines through the cardstock sheet but not through the continuous liner sheet. The continuous through-cut lines define, at least in part, perimeter edges of a printable business card in the cardstock sheet. The printable business card has a surface that is coupled to the ultraremovable adhesive. The printable business card is configured to be removed from the continuous liner sheet exposing the ultraremovable adhesive on the continuous liner sheet and the non-tacky printable business card's surface.

Rejection of Claims 314-318, 320, 321, 324-328, 330, 333, 335-338, 356, 410, and 443-446 Under 35 U.S.C. § 112, Second Paragraph

On page 3 of the Office Action, claims 314-318, 320-321, 324-328, 330, 333, 335-338, 356, 410, and 443-446 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In support of the rejection, the Examiner states the following:

Claim 1 recites "a continuous liner sheet **directly** and releasably secured to the paper cardstock sheet with ultraremovable adhesive" which is unclear and renders the claims vague and indefinite. Since the paper cardstock sheet, the continuous liner sheet and/or the ultraremovable adhesive could comprise more than one layer, it is unclear what is meant by "directly" secured to, e.g. the ordering and number of layers is unclear.

Claim 443 recites "a continuous liner sheet **directly** and releasably secured to the cardstock sheet with ultraremovable adhesive" is unclear and renders the claims vague and indefinite. Since the cardstock sheet, the continuous liner sheet and/or the ultraremovable adhesive could comprise more than one layer, it is unclear what is meant by "directly" secured to, e.g. the ordering and number of layers is unclear. (Emphasis in original.)

Applicants assume the Examiner was referring to independent claim 314 instead of claim 1. Without acquiescing in the propriety of the subject rejection, Applicants have amended claims 314 and 443 so that they no longer recite "directly". Therefore, the subject rejection has been obviated and should be withdrawn.

Rejection of Claims 314, 315, 321, 324, 330, 333, 335-337, 410, 443, 444, 448, 453, 454, 459-463, and 466 Under 35 U.S.C. § 103 Based Upon the Capozzola Patent, the McKillip Patent, and the Popat Patent

On pages 3-6 of the Office Action, claims 314, 315, 321, 324, 330, 333, 335-337, 410, 443, 444, 448, 453, 454, 459-463, and 466 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the Capozzola patent in view of the McKillip patent and the Popat patent. Applicants respectfully traverse this rejection of claims 314, 315, 321, 324, 330, 333, 335-337, 410, 443, 444, 448, 453, 454, 459-463, and 466.

On pages 3-5, and in support of the rejection, the Examiner states the following with respect to independent claims 314 and 443:

Regarding Applicant's claims 314, 443 and 444, Capozzola discloses a sheet (identification tag apparatus, col. 2, lines 56-57 and ref. #10) with a printable tag (col. 2, lines 6-7) comprising a cardstock sheet comprising paper; a continuous liner (over lay, col. 2, line 65 and ref. #101) sheet directly and releasably secured to the cardstock sheet with a layer of ultraremovable adhesive (col. 2, line 64 and ref. #5); continuous through-cut lines (serration, col. 2, line 68 and ref. #107) through the cardstock sheet but not through the continuous liner sheet (figure 2); and the continuous through cut lines defining at least in part perimeter edges of a printable tag in the cardstock sheet (figures 1 and 2). The printable tag has a surface that is coupled to the ultraremovable adhesive (col. 2, lines 62-64), and the printable tag is configured to be removed from the continuous liner sheet exposing the ultraremovable adhesive (figure 2) on the continuous liner sheet and the non-tacky printable tag's surface (col. 3, lines 25-33).

Capozzola fails to disclose that there is more than one business card, e.g. tag/label.

McKillip and Popat both disclose a business form/sheet with a plurality of cards/labels contain[ed] thereon (McKillip, figures 5 and 11 and Popat figure 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate more than one tag/label/business card on the sheet of Capozzola as taught by McKillip and Popat in order to provide more tags per sheet to the consumer. One of ordinary skill in the art would have been motivated to provide more tags per sheet to the consumer because it would be more cost efficient for the consumer.

The preamble/limitation "business card" is deemed to be a statement with regard to the intended use and is not further limiting insofar as the structure of the product is concerned. In article claims, a claimed intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02. Applicant has defined that "business card" as the cut out portion or separable portion of the sheet construction (specification page 1, paragraph 2 and pages 4-5, paragraph 10). Capozzola's tag, McKillip's cards and Popat's labels are deemed to meet this limitation because they all also the cut out portions of the paper to be printed on.

As best understood by the Applicants, the Examiner is apparently taking the position that the Capozzola patent discloses a sheet with a printable tag comprising a continuous liner sheet releasably secured to a cardstock sheet with a layer of ultraremovable adhesive. Applicants respectfully disagree with the Examiner's position and respectfully submit that **there is no disclosure anywhere in the Capozzola patent of an ultraremovable adhesive**. The only alleged support offered by the Examiner of an **ultraremovable** adhesive in the Capozzola patent is at col. 2, lines 62-64, and in Fig. 2. However, all that col. 2, lines 62-64 of the Capozzola patent states is that "[t]he first side of the paper sheet material is smooth to be adhesively removable from the adhesive layer on the over lay 101." Applicants respectfully submit that such a disclosure in the

Capozzola patent falls far short of teaching or suggesting an **ultraremovable** adhesive. Similarly, while Fig. 2 of the Capozzola patent may show an adhesive layer 105, there is no reason to believe, or even to suspect, that adhesive layer 105 shown in the Capozzola patent comprises an **ultraremovable** adhesive.

It appears that perhaps the Examiner is misunderstanding “the paper sheet material is smooth to be adhesively removable from the adhesive layer” to mean a removable adhesive, and equating **removable** adhesives and **ultraremovable** adhesives. Even if an individual does **erroneously** think that the Capozzola patent teaches removable adhesives, equating removable adhesives and ultraremovable adhesives is incorrect. These two terms would not have been regarded as synonymous by a person of ordinary skill in the art. A person of ordinary skill in the art would have known that an ultraremovable adhesive is considerably less tacky than a removable adhesive. In fact, as pointed out by Applicants in their Amendment of October 14, 2010, and as disclosed in the present specification, for example, in paragraph [0023], **ultraremovable adhesives at their highest adhesion levels are roughly half of what they are for conventional removable adhesives.** To illustrate the relatively low tackiness of an ultraremovable adhesive, Applicants note that ultraremovable adhesives are typically the type of adhesive used in a repositionable note, examples of which include an Avery NoteTabs[®] repositionable note or a 3M Post-It[®] repositionable note.

Furthermore, in addition to the fact that the Capozzola patent does not disclose an ultraremovable adhesive, Applicants respectfully submit that, given the intended use of the identification tag of the Capozzola patent, there would have been no reason to use an ultraremovable adhesive therein. The Capozzola patent teaches that its identification tag is to be used by writing information on notational strip 104, removing notational strip 104 from adhesive layer 105, placing notational strip 104 on the inside surface of a shoe (Fig. 3 shows notational strip 104 being positioned for placement under the heel of the person wearing the shoe), removing border 103 from overlay 101, and then placing overlay 101, with adhesive layer 105 facing down, over notational strip 104 so that the overlay 101 secures notational strip 104 to the shoe (overlay 101 is said to be made of a clear plastic

and adhesive layer 105 is said to be transparent). In view of the intended use of the Capozzola patent tag and the stated objective in the Capozzola patent of having the tag withstand wear (presumably, at least in part, by having the tag maintain long-term adherence to a shoe), it would have made no sense for adhesive layer 105 to be made with an ultraremovable adhesive since it is highly unlikely that such an adhesive would be sufficiently tacky to maintain long-term adherence to a shoe, given the rubbing in various directions that would typically be applied to such a tag as a wearer walks, stops and changes direction while wearing the shoe.

Moreover, for at least the reasons of record, the McKillip patent and the Popat patent also *fail* to teach or to suggest the claimed ultraremovable adhesive. In addition, Applicants' arguments of record directed at other deficiencies of the McKillip patent and the Popat patent are incorporated herein by reference.

Accordingly, *neither* the Capozzola patent, *nor* the McKillip patent, *nor* the Popat patent, *nor* the combination of the Capozzola patent, the McKillip patent and the Popat patent teaches or suggests an "ultraremovable adhesive . . .," as required by amended independent claims 314 and 443. Applicants respectfully submit that this 35 U.S.C. § 103 rejection of amended independent claims 314 and 443, and dependent claims 315, 321, 324, 330, 333, 335-337, 410, 444, 448, 453, 454, 459-463 and 466, which depend from amended independent claims 314 or 443, is improper and should be withdrawn.

Rejection of Claims 316, 325, 356, 449, 455 and 465 Under 35 U.S.C. § 103 Based Upon the Capozzola Patent, the McKillip Patent, the Popat Patent, and the Mallya Patent

On pages 6-7 of the Office Action, claims 316, 325, 356, 449, 455, and 465 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the Capozzola patent in view of the McKillip patent and the Popat patent, and further in view of the Mallya patent. Applicants respectfully traverse this rejection of dependent claims 316, 325, 356, 449, 455, and 465.

Claims 316, 325, and 356 depend from amended independent claim 314, and claims 449, 455, and 465 depend from amended independent claim 443. Amended independent claims 314 and 443 are patentable over the Capozzola patent, the McKillip patent, and the Popat patent for at least the reasons above. The Mallya patent is directed toward an ultraremovable adhesive that is a suspension-polymer ultraremovable adhesive. However, as noted above, there would have been no reason to use an ultraremovable adhesive, such as the ultraremovable adhesive of the Mallya patent in the identification tag of the Capozzola patent for at least the reason that a person of ordinary skill in the art would not have expected that an ultraremovable adhesive would provide the requisite level of tackiness for the Capozzola patent tag to maintain long-term adherence to a shoe.

Accordingly, for at least the above reasons, Applicants respectfully submit that this 35 U.S.C. § 103 rejection of dependent claims 316, 325, 356, 449, 455, and 465, which depend from amended independent claims 314 or 443, is improper and should be withdrawn.

Rejection of Claims 317, 318, 320, and 450-452 Under 35 U.S.C. § 103 Based Upon the Capozzola Patent, the McKillip Patent, the Popat Patent, and the Yoshizawa Patent

On pages 7-8 of the Office Action, claims 317, 318, 320, and 450-452 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the Capozzola patent in view of the McKillip patent and the Popat patent, and further in view of the Yoshizawa patent. Applicants respectfully traverse this rejection of dependent claims 317, 318, 320, and 450-452.

Applicants respectfully traverse the subject rejection. Claims 317, 318, and 320 depend from amended independent claim 314, and claims 450-452 depend from amended independent claim 443. Amended independent claims 314 and 443 are patentable over the Capozzola patent, the McKillip patent, and the Popat patent for at least the reasons above. The Examiner relies on the Yoshizawa patent merely to disclose “a primer coat

comprising a polyvinyl alcohol-based primer with silicate (col. 9, lines 25-30).” The Yoshizawa patent does not teach or suggest an “ultraremovable adhesive . . . ,” as required by amended independent claims 314 and 443. The Yoshizawa patent thus *fails* to cure all of the deficiencies of the Capozzola patent, the McKillip patent, and the Popat patent with respect to claims amended independent 314 and 443. Therefore, based at least on their respective dependencies, claims 317, 318, 320 and 450-452 are patentable over the Capozzola patent, the McKillip patent, the Popat patent, and the Yoshizawa patent.

Accordingly, for at least the above reasons, Applicants respectfully submit that this 35 U.S.C. § 103 rejection of dependent claims 317, 318, 320, and 450-452, which depend from amended independent claims 314 or 443, is improper and should be withdrawn.

Rejection of Claims 326, 327, 456, and 457 Under 35 U.S.C. § 103 Based Upon the Capozzola Patent, the McKillip Patent, the Popat Patent, and the Hickenbotham Patent

On pages 8-9 of the Office Action, claims 326, 327, 456, and 457 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the Capozzola patent in view of the McKillip patent and the Popat patent, and further in view of the Hickenbotham patent. Applicants respectfully traverse this rejection of dependent claims 326, 327, 456, and 457.

Claims 326 and 327 depend from amended independent claim 314, and claims 456 and 457 depend from amended independent claim 443. Amended independent claims 314 and 443 are patentable over the Capozzola patent, the McKillip patent, and the Popat patent for at least the reasons above. The Hickenbotham patent is relied upon by the Examiner merely to disclose “crushing the corner of lablestock (sic) for use in printers or copier to provide a diagonal path of relatively low stiffness (col. 6, lines 9-16)”. The Hickenbotham patent does not teach or suggest an “ultraremovable

adhesive . . . ,” as required by amended independent claims 314 and 443. The Hickenbotham patent thus *fails* to cure all of the deficiencies of the Capozzola patent, the McKillip patent, and the Popat patent with respect to amended independent claims 314 and 443. Therefore, based at least on their respective dependencies, claims 326, 327, 456, and 457 are patentable over the Capozzola patent, the McKillip patent, the Popat patent, and the Hickenbotham patent. Moreover, Applicants’ arguments of record directed at other deficiencies of the Hickenbotham patent are incorporated herein by reference.

Accordingly, for at least the above reasons, Applicants respectfully submit that this 35 U.S.C. § 103 rejection of dependent claims 326, 327, 456, and 457, which depend from amended independent claims 314 or 443, is improper and should be withdrawn.

Rejection of Claims 328 and 458 Under 35 U.S.C. § 103 Based Upon the Capozzola Patent, the McKillip Patent, the Popat Patent, and the Hollis Patent

On pages 9-10 of the Office Action, claims 328 and 458 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the Capozzola patent in view of the McKillip patent and the Popat patent, and further in view of the Hollis patent. Applicants respectfully traverse this rejection of dependent claims 328 and 458.

Claim 328 depends from amended independent claim 314, and claim 458 depends from amended independent claim 443. Amended independent claims 314 and 443 are patentable over the Capozzola patent, the McKillip patent, and the Popat patent for at least the reasons above. The Hollis patent is relied upon by the Examiner merely to disclose “[t]he backing sheet has a leading edge and a trailing edge that extend out to form a narrow exposed strip extending the entire width of the liner sheet (col. 5, liner 67 through col. 6, line 1 and figures 3 and 4).” The Hollis patent does not teach or suggest an “ultraremovable adhesive . . . ,” as required by amended independent claims 314 and 443. Thus, the Hollis patent *fails* to cure all of the deficiencies of the Capozzola patent, the McKillip patent, and the Popat patent with respect to amended independent claims

314 and 443. Therefore, based at least on their respective dependencies, claims 328 and 458 are patentable over the Capozzola patent, the McKillip patent, the Popat patent, and the Hollis patent. Moreover, Applicants' arguments of record directed at other deficiencies of Hollis et al. are incorporated herein by reference.

Accordingly, for at least the above reasons, Applicants respectfully submit that this 35 U.S.C. § 103 rejection of dependent claims 328 and 458, which depend from amended independent claims 314 or 443, is improper and should be withdrawn.

Rejection of Claims 338 and 464 Under 35 U.S.C. § 103 Based Upon the Capozzola Patent, the McKillip Patent, the Popat Patent, and the Carlson Patent

On pages 10-11 of the Office Action, claims 338 and 464 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the Capozzola patent in view of the McKillip patent and the Popat patent, and further in view of the Carlson patent. Applicants respectfully traverse this rejection of dependent claims 328 and 458.

Claim 338 depends from amended independent claim 314, and claim 464 depends from amended independent claim 443. Amended independent claims 314 and 443 are patentable over the Capozzola patent, the McKillip patent, and the Popat patent for at least the reasons above. The Carlson patent is relied upon by the Examiner merely to disclose "die cut cards, which are coated with an ink receptive coating (col. 9, line 50 through col. 20, line 3)." The Carlson patent does not teach or suggest an "ultraremovable adhesive . . . ," as required by amended independent claims 314 and 443. The Carlson patent thus *fails* to cure all of the deficiencies of the Capozzola patent, the McKillip patent, and the Popat patent with respect to claims amended independent 314 and 443. Therefore, based at least on their respective dependencies, claims 338 and 464 are patentable over the Capozzola patent, the McKillip patent, the Popat patent, and the Carlson patent.

Accordingly, for at least the above reasons, Applicants respectfully submit that this 35 U.S.C. § 103 rejection of dependent claims 338 and 464, which depend from amended independent claims 314 or 443, is improper and should be withdrawn.

Rejection of Claim 445 Under 35 U.S.C. § 103 Based Upon the Capozzola Patent, the McKillip Patent, the Popat Patent, and the Warther Patent

On page 11 of the Office Action, claim 445 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the Capozzola patent in view of the McKillip patent and the Popat patent, and further in view of the Warther patent. Applicants respectfully traverse this rejection of dependent claim 445.

Claim 445 depends from amended independent claim 443. Claim 443 is patentable over the Capozzola patent, the McKillip patent, and the Popat patent for at least the reasons above. The Warther patent is relied upon by the Examiner merely to disclose “[t]he cards can be provided with a magnetic strip to hold encoded date (sic) or be used as a credit card (col. 5, line 60 through col. 6, line 1 and col. 10, lines 44-55).” The Warther patent does not teach or suggest an “ultraremovable adhesive . . . ,” as required by amended independent claims 314 and 443. Thus the Warther patent *fails* to cure all of the deficiencies of the Capozzola patent, the McKillip patent, and the Popat patent with respect to amended independent claim 443. Therefore, based at least on its dependency, claim 445 is patentable over the Capozzola patent, the McKillip patent, the Popat patent, and the Warther patent.

Accordingly, for at least the above reasons, Applicants respectfully submit that this 35 U.S.C. § 103 rejection of dependent claim 445, which depends from amended independent claim 443, is improper and should be withdrawn.

Conclusion

Appl. No. 09/872,353
Response dated March 29, 2011
Reply to Office Action of December 29, 2010

Applicants believe the amendments and arguments set forth above place this application in condition for allowance. An early notice of allowance is respectfully requested. If for any reason the Examiner finds the application not in condition for a notice of allowance, the Examiner is requested to call the undersigned practitioner at the telephone number listed below to discuss steps to place the application into condition for allowance. No fees are believed due in association with the filing of this amendment. In the event of a payment deficiency, or if additional fees are due, please charge the fees to Avery Dennison's Deposit Account No. 013025.

Respectfully submitted,
AVERY DENNISON CORPORATION

Dated: March 29, 2011 By: /Ronald Ugolick - Reg. No. 57,080/
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